REMARKS

Claims 1-2 are pending in the application. Claim 1 is the sole independent claim.

Statement of Substance of Interview

Applicants thank Examiner Laneau for the courtesies extended at the personal interview on August 23, 2005, and provide this Statement of Substance of Interview in compliance with M.P.E.P. 713.04:

(A) Exhibits. No exhibit / demonstration was shown / conducted.

(B) Claims. The discussion was limited to the sole independent claim (claim 1).

(C) Prior art. Wexler (U.S. Patent No. 5,960,409) and Klug (U.S. Patent No. 6,615,251) were discussed.

(D) Amendments. Not applicable.

(E) Principal arguments by Applicants. Wexler does not teach or suggest selecting an advertisement in response to an advertising request as claimed. Klug is not prior art because it does not antedate the effective filing date of the present application (i.e., October 29, 1996).

(F) Other matters. Applicants' representative discussed the limitations of claim 1, and apprised Examiner Laneau of the nature and status of the related applications.

(G) No agreement reached. Although agreement was not reached at the interview, the Examiner expressed his intention to consider the arguments provided by Applicants' representative, and that further search may be warranted.

The Claims Patentably Define the Invention Over Wexler and Klug

The Office rejected claims 1-2 under 35 U.S.C. § 103(a) as being unpatentable over Wexler (U.S. Patent No. 5,960,409) in view of Klug (U.S. Patent No. 6,615,251). Applicants respectfully traverse this rejection and submit that each pending claim is patentable over the cited art.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the Office bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. To

establish a prima facie case of obviousness, the Office must show that three basic criteria are met. M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. Id.

Applicants respectfully submit that the Office has not established a prima facie case of obviousness for at least the following reasons:

Wexler Does Not Teach or Suggest Selecting an Advertisement In Response To an Advertising Request

Independent claim 1 recites, in part, "selecting an advertisement, based upon stored information about said user node, to send to said user node in response to said first advertising request."

Foremost, the Office bases its support in Wexler for this limitation upon a clear factual deficiency. The Office merely cites to disclosure in Wexler of a banner on which a user can click to access an advertiser web site. See Wexler, col. 4, lines 10-18, as cited in the Office action at page 3, para. 3. Such accessing of an advertiser web site by a user clicking on a banner does not involve an advertising request, much less selection of an advertisement in response to an advertising request as claimed.

Further, in contrast to the claimed invention, the third party accounting and statistical service of Wexler merely "accumulates and tabulates statistical information including the number of clicks on the advertiser's banner, and further provides data indicative of the effectiveness of the banner publisher's Web page as an advertising medium." Wexler, col. 2, lines 57-61. Since the third party service of Wexler only provides accounting and statistical information and does not select ads, it cannot teach or suggest the limitations of the pending claims.

Accordingly, for at least these reasons, Applicants submit that all of the pending claims, independent and dependent, are not rendered obvious under 35 U.S.C. § 103.

Klug Is Removed as Prior Art

Applicants respectfully submit that Klug cannot be used as prior art because Klug's effective date is not prior to October 29, 1996, the effective filing date of the present application. See M.P.E.P. 715(II)(D).

The only application in Klug's patent family with a filing date prior to October 29, 1996 is U.S. Pat. Appl'n No. 08/595,837 (filed February 2, 1996, now U.S. Pat. No. 5,790,785)[1], which does not include nor support the subject matter cited in Klug as the bases for the Office's rejections. The specification of the '837 application does not even mention ads or advertisements, much less teach or suggest selection of an advertisement in response to an advertising request as claimed.

Accordingly, for at least this reason, Applicants respectfully submit that Klug has been removed as prior art, and therefore request that the § 103(a) rejection be withdrawn.

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[1] Klug is a continuation-in-part of a continuation of the '837 application.

CONCLUSION

It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

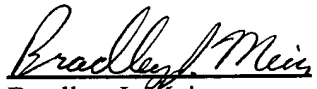
The Office is authorized to charge the three-month extension of time fee of $1020.00 to Deposit Account No. 11-0600. A copy of this page is provided for this purpose.

Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Dated: October 7, 2005



Bradley J. Meier
(Reg. No. 44,236)

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
(202) 220 - 4200 (telephone)
(202) 220 - 4201 (facsimile)